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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,123	07/10/2000	William N. Schilit	FXPL-01022US0 MCF/TAW	8793
23910	7590	11/17/2005	EXAMINER HALIM, SAHERA	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			ART UNIT 2157	

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.	Applicant(s)	
09/613,123	SCHILIT ET AL.	
Examiner	Art Unit	
Sahera Halim	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.  
2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☐ Claim(s) 1-8, 10-14 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is in response to communication filled on July 27, 2005.
2. Claims 1-8, and 10-14 have been amended.
3. Claim 9 has been cancelled.
4. Claims 1-8 and 10-14 are pending.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, and 12 – 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Martin, Jr. et al., U.S. Pat. No. 6,610,105 (hereinafter Martin).

1. Regarding claim 1, Martin discloses a method as claimed, for proving data detection from Web content information for mobile devices comprising (col. 2, line 34 – col. 3, line 51):

receiving a URL from a user (col. 2, line 47 – 49, the server receives a request from a mobile device to access a portal, which is done though a URL request);

accessing a Web page data file identified by the URL (col. 8, line 1 – 6, the portal is accessed by the URL);

detecting a data portion from the Web page data file (See Fig. 3B and col. 9, lines 7 – 37; the portal provides a number links on the mobile device);

searching the content to identify one or more Web content data items, wherein each of the one or more web content data items included in the content portion can be accessed via at least one link indication to provide a service from a mobile device through a wireless connection (col. 3, line 22 – 37 and col. 9, line 18 – 37, the user access services through links such as stacks on a mobile device); and

displaying only the identified one or more web content data item using the at least one link indication on a display of the mobile device (col. 9, line 18 – 37, once the links is selected, data corresponding to the link is displayed on the mobile device).

2. Regarding claim 2, Martin teaches the steps of providing a user keypad selection enabling at least one link indication to be activated; and using the wireless connection to activate at least one link indication when the user keypad selection is made (col. 5, lines 52 - 63).

3. Regarding claim 12, Martin discloses wherein the mobile device can be one of :  
an Internet phone (col. 5, line 18 - 25);  
a personal digital assistant (col. 5, line 18 - 25); and  
a two way pager ((col. 5, line 18 - 25).

4. Reference to claims 13 and 14, Boor teaches wherein the step of detecting and/or searching the content portion from the Web page data file occurs in a network server and within a Web browser (col. 12, line 17 – col. 13, line 14).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3 –5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of De Boor et al., U.S. Pat. No. 6,675,204 (hereinafter Boor).

7. Regarding claim 3, Martin fails to disclose wherein one of the one or more Web content data items is a telephone number. However, Boor teaches the web content data is a telephone number (col. 13, lines 28 – line 58). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Martin by Boor in order to enhance the system functionality.

8. Reference to claim 4, Martin fails to disclose wherein one of the one or more Web content data item is a telephone number. However, Boor teaches the web content data is a telephone number (col. 13, lines 28 – line 58). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Martin by Boor in order to enhance the system functionality. Moreover, Martin and Boor fail to teach the link indication is activated by dialing the number. However, this feature is well known and would have been an obvious modification for person having ordinary skill in the art at the time of the invention to in order to reduce the steps of dialing a number.

9. Regarding claim 5, Martin fails teach wherein one of the one or more web content data item is an address number. However, Boor discloses the web content data is an address number (col. 13, lines 28 – line 58). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Martin by Boor in order to enhance the system functionality.

10. Regarding claim 7, Martin does not teach wherein one of the one or more Web content data item is an e-mail address. However, Boor discloses the Web content data is an e-mail address (col. 13, lines 28 – line 58). It would have been to a person having ordinary skill in the art at the time the invention was made to include the above limitation into Martin's invention to increase system functionality.

11. Claims 10 –11, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin in view of Buckham et al., U.S. Pat No. 6,662,016 (hereinafter Buckham).

receiving a URL from a user (col. 2, line 47 – 49, the server receives a request from a mobile device to access a portal, which is done through a URL request);

accessing a Web page data file identified by the URL (col. 8, line 1 – 6, the portal is accessed by the URL);

detecting a data portion from the Web page data file, the data portion adapted to be enhanced by introducing a link indication to a service (See Fig. 3B and col. 9, lines 7 – 37; the portal provides a number links on the mobile device);

searching the content to identify one or more Web content data items in the content, the web content data included in content portion and adapted to be accessed to provide at least one new link service from a mobile device through a wireless connection (col. 3, line 22 – 37 and col. 9, line 18 – 37, the user access services through links such as stacks on a mobile device);

displaying only the at least one identified web content data using the link indication on a display of a mobile device (col. 9, line 18 – 37, once the links is selected, data corresponding to the link is displayed on the mobile device); and

providing a user keypad selection of the mobile device to show a location for the at least one identified address via a map (col. 5, lines 52 - 63).

Although Martin discloses substantial features of the claimed invention (explained above), he fails to disclose that the web content data item is an address and providing a user keypad selection of the mobile device enabling a map to be provided showing a location for the identified address. However, in an analogous art, Buckham teaches displaying the address on a display of the mobile device and a map to be provided showing a location for the identified address (Fig. 1, numeral 147, Fig. 2, numeral 202, 204 and Fig. 4 and col. 2, lines 24 – col. 4, lines 8). Having the teachings of Martin and Buckham, it would have been obvious for a person having ordinary skill in the art at the time the invention was made to include the above limitation into Martin in order to increase utilizations of the system.

7. Regarding claim 11, Boor discloses receiving a URL from a user (col. 4, lines 18 - 46);

accessing a Web page data file identified by the URL (col. 4, lines 28 - 46);

identifying at least one email address from the one or more content in the Web page items in the content (col. 13, lines 26 – 51);

displaying the identified email address for the user (col. 13, lines 26 – 51);  
providing a user keypad selection of the mobile device (Fig.1, col. 9, lines 34 – 49 and col. 4, lines 18 – 46).

Nonetheless Boor does not disclose displaying the address on a display of the mobile device and an email initiation. However, Buckham teaches displaying the address on a display of the mobile device and an e-mail initiation (co. 9, line 7 – 12 and



Fig. 1, numeral 147, Fig. 2, numeral 202, 204). It would have been obvious for a person having ordinary skill in the art at the time the invention was made to modify Bore by Buckham order to enhance user stratification by providing more functionality to the system.

8. Claims 6 and 8 have the same similar limitations as to claims 10 and 11; therefore, they are rejected under the same rational.

### ***Response to Arguments***

9. Applicant's arguments filed July 27, 2005 have been fully considered but they are not persuasive.

10. In regards to claims 1, 2, and 12 –14, the applicant argues that the content in his invention is dynamic and it is static in the reference. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., dynamic content) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The limitations of "detecting a content portion from the Web page data file", "searching the content portion to identify one or more Web content data items", and "displaying only the identified one

or more Web content data items on a display of the mobile device” does not indicate that the content is dynamic and all of these limitations are thought by Martin.

11. In regards to claims 3-5 and 7 the applicant argues that the reference does not qualify as a reference since it was filed two years later than the present invention. The Boor reference is a patent, which has a continuation date of a Patent that was filled on April 8, 1998. The examiner is relying on the continuation date, not on the filling date of the Boor reference. Therefore Boor reference does qualify as a reference.

12. In regards to claims, 10, 11, 6, and 8, the applicant argues that the references fail to teach displaying content on a mobile device having limited display space or detecting/identifying content data items in a web page. The examiner disagrees. Again the applicant is relying on limitations, which are not cited in the claims such content on a mobile device having limited display space. The limitation of detecting/identifying content data items in a web page is thought by both references (please refer to the above rejection). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

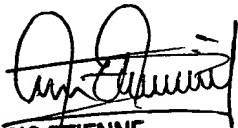
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sahera Halim whose telephone number is (703) 305-8054. The examiner can normally be reached on M-F from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2157

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sahera Halim  
Patent Examiner  
AU: 2157  
November 14, 2005



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